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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,167	08/26/2003	Gisela Hahn	0503-1115	4771
466 7590 08/06/2007 YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER HANDY, NIKKI R	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 08/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/649,167

Applicant(s)

HAHN ET AL.

Examiner

Nikki Handy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15,17-50 and 70-75 is/are pending in the application.
- 4a) Of the above claim(s) 51-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15,17-50 and 70-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/20/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 15, 17-50 and 70-75 are pending. Claim 16 has been cancelled.

Receipt of Applicant's amended claims and remarks/arguments filed on February 22, 2007 are acknowledged.

It is noted that Applicants provisionally elect Group II, Claims 31-43, which is drawn to a concentrate which further comprises an active agent, one functional additive and/or one auxiliary, with traverse. The traversal is on grounds that all inventions of Groups I-III are related. The traversal is found persuasive. Therefore upon reconsideration all Claims will be examined.

Election of Species Requirement

Applicants provisionally elect polybiguanide or a polybiguanide salt as the elected species. Claims 51-69 are withdrawn as being non-elected species.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 34-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Referring to these claims, which depend from Claim 33, it is unclear what "said weight" is referring to, i.e. is the "said weight" limiting the active, the additive or the auxiliary, etc.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15, 17-30, 45-50 and 70-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US Patent No. 6,375,727 B1, hereinafter Walker '727 patent) in view of Bell et al. (US Patent 6,172,117, hereinafter, Bell '117 patent).

Applicant's Invention

Applicants' claim a liquid concentrate preservative that comprises 3-iodo-2-propynyl butyl carbamate, a liquid carrier and stabilizer.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

Walker teaches an iodine containing biocide that includes 3-iodo-2-propynyl butyl carbamate (also IPBC). See Column 2, lines 8-10. Walker further teaches a composition that includes a solvent, such as water (an auxiliary agent) and water miscible solvents, such as, glycol (liquid carrier). See Column 5, lines 49-51. The composition when in concentrated form, preferably contains about 20 to about 70% by weight and preferably from about 30 to 65% by weight. See Column 5, lines 53-55. Example 1 shows the performance of watering and/or stirring to form a concentrate containing about 3.7% IPBC. See column 6, line 47. The IPBC may be any grade of

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IPBC including, but not limited to, an essentially pure commercial grade IPBC in solid form and a commercially available 40% grade in solvent. See Column 3, lines 34-37.

Column 9, Table 5, line 42 shows IPBC in water at a concentration of 0.15%.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Walker does not teach a stabilizer. For this reason Bell is joined. Bell et al. teach biocidal preservative compositions that include other components to enhance the function of the biocide, such as, formic acid. See Column 13, lines 39, 40 and 48. The preferred compositions include from about 0.01 to about 50% by weight of biocide, more preferably from about 0.1% to about 10% biocide. See Column 13, lines 54-56.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of Walker and Bell. One would have been motivated to do so because the teachings of Bell describe biocidal preservatives that are used for preventing rotting and deterioration of wood.

With respect to Claims 71-73, it is noted claims are product-by-process limitations. "[E]ven though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production, if the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is

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unpatentable even though the prior art was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir. 1985).

Claims 31-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US Patent No. 6,375,727 B1, hereinafter Walker '727 patent) and Bell et al. (US Patent 6,172,117, hereinafter, Bell '117 patent) in further view of Stockel (US Patent Application No. 2003/0032768 A1).

Applicant's Invention

Applicants' claim a liquid concentrate preservative that comprises 3-iodo-2-propynyl butyl carbamate, a liquid carrier and stabilizer.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

The teachings of Walker and Bell have been discussed above.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

The combined references of Walker and Bell do not teach an active agent, polybiguanide. For this reason Stockel is joined. Stockel teaches polybiguanides that are especially useful as the active ingredient in fungicidal or bactericidal applications. The polyguanides are effective biocidal substances, e.g., at concentrations of 1.0 to 1,000 ppm. See page 3, paragraph 31.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

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It would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of Walker, Bell and Stockel. One would have been motivated to do so because the teachings of Stockel describe polybiguanides having high level of biocidal activity accompanied by a low level of toxicity to host organisms and therefore are useful as biocides.

With respect to Claims 38 and 39, the preferred weight ratio of IPBC to polybiguanide is 10:1 to 1:10, more preferably 1:2 to 2:1. Walker teaches 0.01-1 parts of IPBC and 0.0001-1% of polybiguanide.

With respect to Claims 40-43, Walker teaches 0.01-1 part IPBC and 0.001-1% of polybiguanide.

Claim Objection

Claim 75 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 74. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki Handy whose telephone number is (571) 272-9923. The examiner can normally be reached on Monday-Friday 8:30 am-5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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